

REMARKS

Favorable reconsideration and allowance of this application are requested.

1. Discussion of Amendments

By way of the amendment instructions above, claims 20, 22 and 23 have been amended so as to address certain informalities therein.

In addition, each of the independent claims 10, 16, 20 and 22 has been revised to clarify that the magnets are "permanent" magnets. Support for such an amendment can be found in the originally filed specification, for example, at page 4, line 23. (*"The apparatus has a magnet head 2 comprising 96 elongated permanent magnets...."*)

Therefore, following entry of this amendment claims 10-23 will remain pending herein for consideration.

2. Request for Continued Examination

As a procedural note, the present amendment is being filed concurrently with a formal Request for Continued Examination (RCE) under 37 CFR §1.114. Accordingly withdrawal of the "finality" of the November 12, 2009 Official Action is in order so as to allow entry and consideration of the amendments and remarks presented herewith.

3. Response to 35 USC §112 Rejection

The amendments made to claims 20, 22 and 23 are believed to address the rejection advanced under 35 USC §112, second paragraph. Specifically, antecedent basis for the term "separating surface" has been introduced.

4. Response to 35 USC §103(a) Rejection

The only issue remaining to be resolved in this application are the rejections advanced against claims 10-16 and 19 based on Ekenburg et al (USP 5,567,326) in view of Hatch (USP 6,514,415) and against claims 17-18 and 20-23 based on Ekenburg et al and Hatch and further in view of Gombinsky et al (USP 6,409,925). As will become evident from the following discussion, such references are inappropriate to reject the claims pending herein.

In this regard, applicant notes that the Ekenberg device comprises paramagnetic pins, which are then temporarily magnetized by the magnet pack. The device of the presently claimed invention however comprises real (i.e., "permanent") magnets.

To an ordinarily skilled person it would be readily apparent that the magnet pack of Ekenberg et al would preferably comprise one large magnetic plate. However, since one large monolithic magnetic plate is probably not readily available commercially but instead would be custom manufactured only if specifically requested at increased cost, Ekenberg et al have suggested that the pack be constructed of several individual magnets that are readily available. And in fact the magnetic field thus created resembles rather well the magnetic field that is created from one monolithic plate magnet. This fact is evidenced from the accompanying Declaration of one of the co-inventors, Mr. Jukka Tuunanen (hereinafter "the Tuunanen Declaration"). As shown by the computer simulations in the Tuunanen Declaration, the magnetic field of a single plate magnet and that of multiple magnets as proposed by Ekenberg et al are substantially the same.

The ordinarily skilled person would also understand that the inherent problem of the Ekenberg et al proposal is that the magnetic field weakens towards the ends of the pins, the more the longer the pins are. The ordinarily skilled person would thus also understand that this problem would only be increased if neighboring magnets were

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inversely orientated, as a strong field between the pins is formed already in the upper end. This fact is also confirmed by the third figure in the Tuunanen Declaration.

There is also a strong misbalance of field density. So, the ordinarily skilled person would certainly not invert any magnets in the Ekenberg et al device. There is simply no practical sense in it since it would further decrease the field strength towards the ends of the pins where the particles should be collected. As such, the ordinarily skilled person would be prejudiced against inversely oriented magnets for these reasons.

In the construction of Hatch, magnets are indeed inversely oriented. The purpose of Hatch however is to create a low field which extends only to the bottoms of the vessels. The particles are then held tightly on the bottoms when liquid is removed.

The advantages of the present invention are discussed on page 3. Such advantages are in no way obvious on the basis of Hatch. And as noted previously, there would be no motivation provided by Hatch to invert the magnets of Elkenberg et al since to do so would weaken the field strength towards the ends of the pins where the particles are to be collected.

For these reasons, therefore, the presently claimed invention would not be "obvious" in view of Ekenberg et al and Hatch.

Gombinsky et al is noted as disclosing a reciprocally movable over for a separating device. However, this disclosure does not cure the deficiencies of Elkenberg et al and Hatch as already discussed.

Accordingly withdrawal of all rejections advanced under 35 USC §103(a) is in order. Early receipt of the Official Allowance Notice is awaited.

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5. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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